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UNITED STATES DISTRICT COURT  
DISTRICT OF OREGON  
PORTLAND DIVISION

MARATHON SAVINGS BANK,

Plaintiff,

v.

AFFORDABLE WEBHOSTING, INC.,

Defendant.

Case No. \_\_\_\_\_

COMPLAINT

JURY TRIAL DEMANDED

## **COMPLAINT**

The Plaintiff, Marathon Savings Bank (“Marathon”), by its attorneys Holland & Knight LLP, for its Complaint against Defendant Affordable Webhosting, Inc. (“AWI”), alleges as follows:

### **NATURE OF THIS ACTION**

1. This is an action for cybersquatting on the domain name WWW.MARATHONBANK.COM in violation of 15 U.S.C. § 1125(d).

2. AWI has no rights in the MARATHON BANK name and mark, has registered WWW.MARATHONBANK as its domain name, and has used that domain name in bad faith to deceive and confuse the consuming public.

### **PARTIES**

3. Marathon is a Wisconsin corporation, with its principal place of business at 500 Scott Street, Wausau, Wisconsin 54403. At all times relative to this Complaint, Marathon has been in the business of offering banking and banking-related services.

4. Upon information and belief, and according to the Whois database of the registrar, Name.com, Inc., the registrant of the WWW.MARATHONBANK.COM domain is, Affordable Webhosting, Inc., Advertising, located at 370 Laneda Avenue, Suite 1508, Manzanita, Oregon 97130-1508.

### **JURISDICTION AND VENUE**

5. This Court has subject matter jurisdiction of this action pursuant to 28 U.S.C. §§ 1331 and 1338, with reference to Lanham Act § 43 (15 U.S.C. § 1125).

6. This Court has personal jurisdiction over AWI because AWI maintains its principal place of business in this state, and, on information and belief, AWI sold and/or offered for sale advertisement space in this state.

7. Venue is proper in this district pursuant to 28 U.S.C. §1391.

### **STATEMENT OF FACTS**

#### **I. Marathon and the MARATHON SAVINGS BANK Trademark**

8. Marathon is the owner of all right, title and interest in and to the MARATHON SAVINGS BANK trademark through its continuous and widespread use of the trademark in commerce since at least as early as 1993.

9. Marathon has been offering its services under a name incorporating the term “MARATHON” since 1902 and is the oldest bank in Marathon County, Wisconsin, United States.

10. Marathon’s rights in the MARATHON SAVINGS BANK trademark are valid, subsisting, and in full force and effect.

11. Marathon is the only active FDIC-insured bank in the United States using the name “Marathon.”

12. Marathon operates a bank, offering banking and related services under the MARATHON SAVINGS BANK trademark.

13. Marathon’s banking services include: deposit services, such as checking, savings, money market; certificate of deposits and individual retirement accounts; residential, commercial and construction loans, mortgages, home equity loans and small business loans; and banking services includes cash management products, deposit accounts, and feature-rich online services.

14. Marathon uses the MARATHON SAVINGS BANK name and trademark to offer its banking services throughout the United States at its bank locations and on the internet at its website: [www.marathonsavingsbank.com](http://www.marathonsavingsbank.com).

15. Marathon has been offering its services at its bank locations under a name incorporating the term “MARATHON” for over a century.

16. Since the www.marathonsavingsbank.com website was registered on April 16, 1999, Marathon has actively promoted its banking services online under the MARATHON SAVINGS BANK trademark and, as a result, has developed a significant presence on the internet.

17. Marathon's advertising and marketing has been successful.

18. Marathon had over \$144,000,000 in total assets and over \$125,000,000 in total deposits as of March 2017.

19. Marathon actively promotes its MARATHON SAVINGS BANK services through popular social media sites. Specifically, Marathon has attracted followers on its Facebook profile, Twitter social network website, and LinkedIn professional network page.

20. Marathon continues to grow its business under the MARATHON SAVINGS BANK MARK by expanding the banking services it offers to include mobile banking and additional online services, and by establishing new bank branch locations.

21. Long before the acts of AWI complained of herein, and by virtue of Marathon's extensive marketing of its MARATHON SAVINGS BANK banking and related services, Marathon's MARATHON SAVINGS BANK mark has become recognized by consumers throughout United States as designating Complainant as the source of Marathon's services.

## **II. AWI's Use of the Domain Name**

22. The WWW.MARATHONBANK.COM domain name is virtually identical to Marathon's valuable MARATHON SAVINGS BANK trademark. The dominant portion of Marathon's mark is comprised of the terms "MARATHON" and "BANK," making the WWW.MARATHONBANK.COM domain name virtually identical to Marathon's MARATHON SAVINGS BANK mark and misleading to consumers.

23. AWI has no rights or legitimate interests in the WWW.MARATHONBANK.COM domain name.

24. The domain name at issue, WWW.MARATHONBANK.COM, is not the name of AWI, nor can it be considered its business name or common trade name. AWI is not a bank, financial institution, or other entity that can use the title of “bank.” There is no legitimate basis for AWI’s registration of WWW.MARATHONBANK.COM.

25. AWI is not, and has never been, authorized to use Marathon’s MARATHON SAVINGS BANK trademark or the virtually identical MARATHON BANK trademark.

26. AWI has no senior rights to the WWW.MARATHONBANK.COM domain name. Respondent did not register the domain name until January 21, 2004, nearly five years after Marathon registered the WWW.MARATHONSAVINGSBANK.COM domain, over a decade after Marathon commenced use of the MARATHON SAVINGS BANK trademark in commerce, and over a century after Marathon began operating under a similar name incorporating the term “MARATHON.”

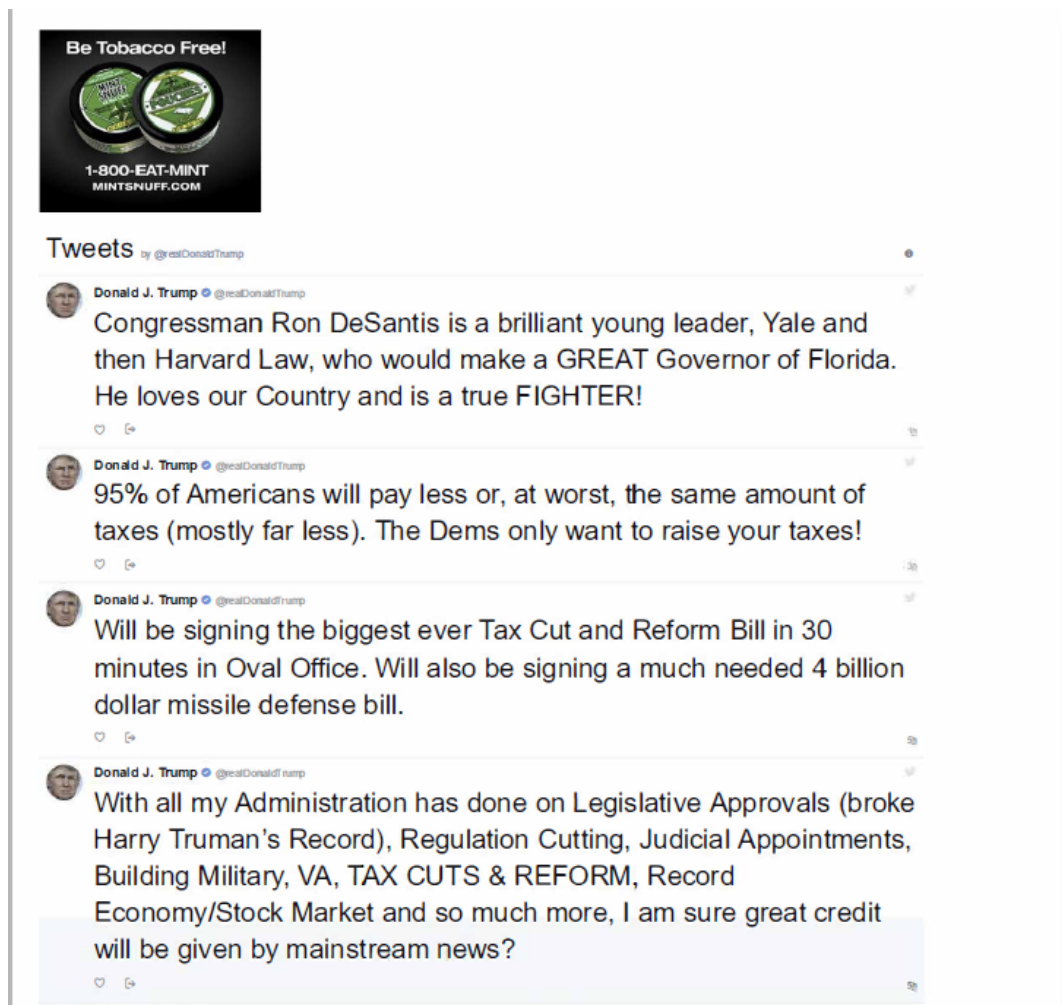
27. Prior to any notice to AWI of the dispute, there is no evidence that AWI used, or made preparations to use, the WWW.MARATHONBANK.COM domain name in connection with a bona fide offering of goods or services.

28. When Marathon became aware of AWI’s registration of the domain name in June 2017, AWI was using the domain name in order to misleadingly divert consumers by attracting them through the virtually identical domain name and then collecting revenue by featuring “sponsored” links on its search engine.

29. Later, in December 2017, AWI changed the [www.marathonbank.com](http://www.marathonbank.com) domain so that it redirected to [www.politco.com](http://www.politco.com), a commercial website with political commentary. For example, the top of the website had an advertisement for Mint Snuff that stated:

Welcome to POLITCO.com - President Donald Trump's Personal Tweets, No Twitter Account Required (not Politico.com) Scroll down. Newest tweet is at the top. We are funded by advertisers who believe in getting the facts directly from the source. Proudly funded by the Oregon Mint Snuff Company, who helped the Secret Service quit chewing tobacco under the Bush Administration. In fact, Bush Senior's driver chewed Mint Snuff! So did the White House snipers, all are now tobacco-free!

Below that statement, an example of the webpage's material is as follows:



30. This use of the domain name for commercial gain continued until January 2018.

31. Shortly after AWI received Marathon's most recent cease and desist letter, dated January 26, 2018, AWI altered the website under the domain name to display the opinion from the UDRP proceeding in this case. Such actions were clearly intended to annoy and harass Marathon.

32. If not enjoined by this Court, AWI will continue to use the WWW.MARATHONBANK domain name and will revert to using the domain name for commercial gain.

### **III. AWI's Cybersquatting**

33. Upon information and belief, AWI obtained the domain name registration WWW.MARATHONBANK.COM with the intent to profit on the MARATHON SAVINGS BANK mark.

34. AWI registered the domain name WWW.MARATHONBANK.COM in bad faith. In particular, Respondent registered the web site with the intent of creating a "parked page" with sponsored links that misuses a mark virtually identical to Marathon's MARATHON SAVINGS BANK mark by taking advantage of internet users who will type the particular good or services they are seeking directly into their browsers rather than using an internet search engine.

35. While the website associated with the WWW.MARATHONBANK.COM domain name was a parked page, the web site advertised the domain name as for sale, further demonstrating that it is not tied to any bona fide commercial use by AWI.

36. AWI's registration and use of the domain name constitutes bad faith.

37. AWI's offer to sell the domain name at an extremely high price demonstrates that AWI acquired the domain name primarily for the purpose of selling the domain name registration to

Marathon, or to a competitor of Marathon, for valuable consideration in excess of AWI's out-of-pocket costs directly related to the domain name.

38. Marathon previously inquired about purchasing the WWW.MARATHONBANK.COM domain from AWI through an outside vendor. In response, AWI demanded an excessive price of initially \$275,000 then \$375,000.

39. The typical cost to purchase an unregistered domain name the WWW.MARATHONBANK.COM registrar Name.com, Inc. is less than \$20.00. This cost is vastly disproportionate to AWI's excessive prices, demonstrating bad faith.

40. Upon information and belief, AWI has registered the WWW.MARATHONBANK.COM domain primarily for the purpose of disrupting the business of Marathon.

41. By registering the domain name, AWI is not allowing Marathon to use the WWW.MARATHONBANK.COM domain to advertise, promote and sell its banking services.

42. AWI's use of the WWW.MARATHONBANK.COM domain is used to attract consumers for commercial gain by deceptively leading consumers to believe that Marathon is affiliated in some way with Marathon or that its website is sponsored, approved or endorsed by Marathon.

43. The WWW.MARATHONBANK.COM domain is merely used to advertise sponsored links related to banking and financial services.

**COUNT I: CYBERSQUATTING**  
**LANHAM ACT § 32(D) (15 U.S.C. 1125(D))**

44. Marathon realleges and incorporates by reference as if fully set forth herein the allegations contained in paragraphs 1 through 43.



45. AWI's registration and use of the WWW.MARATHONBANK.COM domain name constitutes bad faith.

46. AWI's use of the WWW.MARATHONBANK.COM domain name and maintenance of the WWW.MARATHONBANK.COM website violates the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d), in that AWI has no rights in the MARATHON BANK name and mark, has registered WWW.MARATHONBANK as its domain name, and has used that domain name in bad faith to deceive and confuse the consuming public.

47. If not enjoined by this Court, AWI will continue to use the WWW.MARATHONBANK domain name and maintain the WWW.MARATHONBANK website for commercial gain.

48. AWI's registration and use of the WWW.MARATHONBANK domain name has caused, and will continue to cause, irreparable harm to Marathon for which there is no adequate remedy at law.

49. AWI has been unjustly enriched and has damaged Marathon's business and marks through his wrongful use of the MARATHON BANK name and mark in the WWW.MARATHONBANK domain name.

50. AWI has engaged in repeated and willful infringement and is liable to Marathon under 15 U.S.C. § 1117.

### **PRAYER FOR RELIEF**

Wherefore, Marathon requests that this Court enter the following relief for Marathon and against AWI and its agents, representatives, and all persons acting or claiming to act on its behalf or under its direction or authority, and all persons acting in concert or in participation with AWI:

- A. An order restraining and enjoining AWI from doing and engaging in any of the acts described above, including engaging in the promotion and sale of the WWW.MARATHONBANK domain name, and directing them to conform with each and every provision of this prayer for relief;
- B. An award for damages due to the injury to its business, reputation and loss of goodwill by reason of AWI's actions, including without limitation the loss of lost sales, lost sales opportunities, and other actual damages;
- C. An award of punitive damages against all Defendants;
- D. An award of Marathon's costs and disbursements in pursuing this action, including its reasonable attorneys' fees;
- E. An order requiring AWI to assign Marathon the registration of the WWW.MARATHONBANK domain name to Marathon; and
- F. That Marathon has such other and further relief as this Court may deem appropriate.

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**JURY DEMAND**

Marathon requests a trial by jury on all issues triable by jury.

Dated: February 9, 2018

Respectfully submitted,

HOLLAND & KNIGHT LLP

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BANK